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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,828	11/16/2001	Omid McDonald	9-15504-1US	7647
20988	7590	10/20/2005	EXAMINER	
OGILVY RENAULT LLP 1981 MCGILL COLLEGE AVENUE SUITE 1600 MONTREAL, QC H3A2Y3 CANADA			THAI, HANH B	
			ART UNIT	PAPER NUMBER
			2163	
DATE MAILED: 10/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,828

Applicant(s)

MCDONALD ET AL.

Examiner

Hanh B. Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 7/19/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed July 19, 2005 have been fully considered but they are not persuasive.

Applicant argues on page 7: "Novak neither teaches nor suggests calculating a change detection code for record in the memory or storing a respective change detection code in the memory of the electronic token."

Examiner responds: Office personnel are to give claims their broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 2111 - § 2116.01.

Applicant does not specifically point out what the change detection code is. Therefore, the Novak's teaching of calculating checksum (page 6, lines 1-24) of each record in the change log of the mobile phone (page 2) and storing the checksum in the SIM card (page 3, line 25-page 4, line 12; page 6, lines 1-10 and page 6, line 25-page 7, line 6) still reads on the claimed features calculating a change detection code for record in the memory or storing a respective change detection code in the memory of the electronic token.

Applicant argues on page 8: "Yoshimura et al. do not teach a flag that indicates a type of change."

Examiner responds: Yoshimura discloses a plurality of flags where each flag indicates a different value of change (col.15, lines 30-48, Yoshimura). Therefore, the teaching of Yoshimura reads on the claimed feature of a flag that indicates a type of change.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 23 is rejected under 35 U.S.C. 102(e) as being anticipated by Novak et al. (WO 01/03409).

Regarding claim 23, Novak discloses a method applied by an electronic token for identifying changed records in a memory of the electronic token, the method comprising:

- calculating at least one change detection code (CDC) “calculat for each record of the file and storing the respective CDCs in a memory of the electronic token “SIM card” (page 3, line 25-page 4, line 12; page 6, lines 1-10 and page 6, line 1 to page 7, line 6, Novak);
- comparing the calculated CDC with a stored CDC stored in the memory in order to determine if at least one associated record has changed since the stored CDC was calculated (page 3, line 25-page 4, line 12; page 6, lines 1-10 and page 6, line 25-page 7, line 6, Novak); and
- if the calculated CDC is not equal to the stored CDC, executing a predefined algorithm to effect registration of a change, and saving the calculated CDC as the stored CDC (page 6, line 25 to page 7, line 6, Novak).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Novak et al. (WO 01/03409) in view of Yoshimura et al (US 6,385,199 B2).

Regarding claim 6, Novak discloses a method for identifying changed records in a file on an electronic token, the method comprising steps of:

- calculating a change detection code (CDC) for each record in the memory and storing the respective CDCs in the memory of the electronic token (page2 and page 6, lines 1-3, Novak);
- comparing the calculated CDC with the stored CDC in order to determine if the record has changed since the stored CDC was calculated (page 3, line 25-page 4, line 12; page 6, lines 1-10 and page 6, line 25-page 7, line 6, Novak); and
- if the calculated CDC is not equal to the stored CDC, executing a predefined algorithm to effect registration of a change, and saving the calculated CDC as the stored CDC (page 6, line 25 to page 7, line 6, Novak).

Novak, however, does not explicitly disclose one of a plurality of flags for each change depending on a type of change, so that different types of change can be differentiated.

Yoshimura, on the other hand, discloses the communication system that exchanges information

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between two nodes including a plurality of flags for each change depending on a data type of change (col.15, lines 30-58, Yoshimura). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Novak to include the claimed feature as taught by Yoshimura. The motivation of doing would have been to detect the change that provides software efficiency and increase hardware's performance (page 1, lines 19-20, Novak).

Regarding claim 2, Novak/ Yoshimura combination further discloses a step of calculating a cyclic redundancy check (page 6, lines 1-10, Novak).

Regarding claim 3, Novak/ Yoshimura combination further discloses a step of determining if the at least one associated record is changed and yields information regarding the change, the information being input to the predefined algorithm (page 6, lines 1-10, Novak).

Regarding claim 4, Novak/ Yoshimura combination further discloses the step of issuing a message to an electronic token reader in which the electronic token is docked, the message containing at least one parameter regarding the change for use by a registering element to which the message is sent by a token-resident applet via the electronic token reader (page 7, Novak).

Regarding claim 5, Novak/ Yoshimura combination disclose a step of setting a response pending flag which is cleared if an acknowledgement of the message is received, wherein the flag is used to indicate that a message was not acknowledged (pages 7-8, Novak).

Regarding claim 7, Novak/ Yoshimura combination disclose a step of using any flag set in association with the stored CDC, in conjunction with the values of the stored CDC and calculated CDC to determine if the record was changed since a last acknowledged message related to the record was sent (page 3, line 25-page 4, line 12; page 6, lines 1-10 and page 6, line 25-page 7, line 6, Novak).

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Regarding claim 8, Novak/ Yoshimura combination disclose a step of sending the message to the registering element, which performs at least one of: synchronization of data across multiple data stores; update of a system with respect to the record; back-up of the record; and provision of a service feature in dependence on the change to the record (page 2, line 14 to page3, line 20, Novak).

Regarding claim 9, Novak/ Yoshimura combination disclose steps of issuing a short message service message to a service provider that has access to the registering element (page 2, line 14 to page3, line 20, Novak).

Regarding claim 10, Novak/ Yoshimura combination disclose steps of: receiving information relating to the change; formulating a notice of change (NOC) message; and inserting as many NOC messages as possible into the SMS message before sending the SMS message (pages 6-7, Novak).

Regarding claim 11, Novak/ Yoshimura combination disclose that the electronic token is a subscriber identity module and the step of comparing further comprises a step of applying a comparison algorithm that executes on the subscriber identity module, the comparison algorithm being adapted to compare a CDC of each of a plurality of abbreviated dialing numbers in the file; and the step of issuing comprises a step of directing a SMS message to the registering element, which is adapted to perform at least one of the following: ensure conformity of the file with other versions of the file stored elsewhere; back-up the file; and, provide a service feature in dependence on the change (page 3, line 25-page 4, line 12; page 6, lines 1-10 and page 6, line 25-page 7, line 6, Novak).

Regarding claim 12, Novak/ Yoshimura combination disclose steps of formulating the message by inserting the at least one parameter into respective fields of the message, and forwarding the message to the registration element (col.15, line 30-col.16, line 54, Yoshimura).

Regarding claim 13, Novak/ Yoshimura combination disclose steps of inserting a record identifier, and information that specifies the change (Fig 11A-B and corresponding text, Yoshimura).

Regarding claim 14, Novak/ Yoshimura combination disclose a step of inserting a value that indicates one of the following: the record was added; the record was deleted; and the record was modified (page 7, Novak).

Regarding claim 15, Novak discloses an apparatus for providing a service to a subscriber having an electronic token, the apparatus comprising:

a change detection applet stored on the electronic token (see page 6, lines 1-3, Novak) adapted to be executed by a processor of the electronic token, the applet being adapted to identify any record that has been changed since a change detection code (CDC) for the record was calculated and stored in a memory of the electronic token, by calculating a current CDC with the stored CDC for the record (see page 2, lines 13-22 and page 4, lines 1-12, and see page 6, line 25 to page 7, line 3, Novak).

Novak, however, does not disclose the sending a notice of change (NOC) message to a registering element for registering detected changes. Yoshimura, on the other hand, discloses the communication system that exchanges information between two nodes including a plurality of flags for each change depending on a data type of change (col.15, lines 30-58, Yoshimura). It would have been obvious to one of ordinary skill in the art at the time of the invention was made

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to modify Novak to include the claimed feature as taught by Yoshimura. The motivation of doing so would have been to easily detect the change. The motivation of doing would have been to detect the change that provides software efficiency and increase hardware's performance (page 1, lines 19-20, Novak).

Regarding claim 16, Novak/ Yoshimura combination discloses the change detection applet calculates a cyclic redundancy check (CRC) to derive the current CDC (see page 6, lines 1-10, Novak).

Regarding claim 17, Novak/ Yoshimura combination discloses back up records for which the NOC message was generated; synchronize the file with other files remotely stored but commonly associated with a subscriber; and, provide a service dependent upon the detected change (page 4, lines 13-20, Novak).

Regarding claim 18, Novak/ Yoshimura combination discloses the electronic token is docked in a communications enabled device that comprises an electronic token reader adapted to exchange data in conformity with a predetermined protocol (col.15, lines 30-58, Yoshimura).

Regarding claim 19, Novak/ Yoshimura combination discloses a subscriber identity module (SIM) card compliant with a global system for mobile communications (GSM) standard; and a universal SIM (USIM) card (see Fig.2-3 and corresponding text, Novak).

Regarding claim 20, Novak/ Yoshimura combination discloses the communications enabled device is adapted to function as a short message service (SMS) enabled telephone (page 4, lines 13-20 and pages 6-7, Novak).

Regarding claim 21, Novak/ Yoshimura combination discloses a data store for storing a set of response pending flags that are associated with a list of records in the file, and the change

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detection applet is further adapted to use the set of response pending flags to determine if a record may have been changed since a last NOC message for the record was acknowledged (col.15, lines 30-58, Yoshimura).

Regarding claim 22, Novak/ Yoshimura combination discloses the set of response pending flags comprises at least two flags used to encode change information, and the change detection applet is further adapted to use the plurality of flags, in conjunction with the stored CRC and current CRC, to determine if a notice of change message related to the record is to be sent (col.2, line 34-col.3, line18 and col.15, lines 30-58, Yoshimura).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B. Thai whose telephone number is 571-272-4029. The examiner can normally be reached on 8 AM - 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hanh B Thai
Examiner
Art Unit 2163

October 12, 2005



UYEN LE
PRIMARY EXAMINER